

## **REMARKS/ARGUMENTS**

### **I. Status of the Claims**

After entry of this amendment, claims 1-63 are pending. Claims 8-10, 15-25 and 49-63 are currently presented. Claims 1-7, 11-14 and 26-48 are withdrawn. No claims are cancelled or amended.

### **II. The Invention**

The present invention provides a family of dendrimers that are useful as, inter alia, supports, vectors, carriers or delivery vehicles for a variety of compounds in biomedical and technological applications. For example, the macromolecules may be used for the delivery of drugs, genetic material, imaging components or other functional molecule to which they can be conjugated. An additional feature of the macromolecules is their ability to be targeted to selected organs, tumors, or types of tissues.

### **III. The Teleconference**

Applicant thanks Examiner Riley for taking time on Tuesday, February 28, 2006 to discuss the Office Action with Applicant's representative, Todd Esker, in a teleconference.

During this teleconference, the Applicant's representative described the support in the specification for the term "free of urea side products". Applicant's representative also asked Examiner Riley if she would allow the introduction of a declaration by Prof. Frechet which explains the differences between the current invention and the prior art. Examiner Riley authorized the introduction of this declaration. Applicant thanks the Examiner for allowing us the opportunity to bring additional information regarding patentability to her attention.

### **IV. Response to the Rejection**

#### ***Under 35 U.S.C. § 112, first paragraph, written description***

Claims 8-10, 15-25 and 49-63 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner states that

the specification lacks support for the phrase "wherein said composition of matter is free of urea side products". Applicants traverse.

The Examples section of the specification describes compositions of matter which are free of urea side products. Example 1 on pages 51 and 52 describes the preparation of an agent used in dendrimer formation, compound 2. This compound was purified by filtration and recrystallization, affording

a product in which no impurities resulting from the presence of DCC by-products can be detected.

U.S. Pat. App. No. 09/963,858, Page 51, lines 30-31

This result was confirmed by mass spectrometry, nuclear magnetic resonance spectroscopy, infrared spectroscopy and elemental analysis as presented on page 52.

This urea side product-free anhydride was then used in various dendrimer generation steps described in Examples 2, 5, 6, 7, and 8. Since a carbodiimide such as DCC was not used in these dendrimer generation steps, the compositions of matter produced by the methods of these Examples are necessarily free of urea side products. Since this phrase is supported by the Examples as originally filed, claims 8-10, 15-25 and 49-63 comply with the written description requirement. Therefore, Applicants respectfully request its withdrawal.

In the February 28, 2006 teleconference, Examiner Riley indicated that she would consider a second declaration by Prof. Frechet which describes the differences between the prior art and the current invention. At this time, Applicants therefore submit this declaration which clearly describes the inability of the methods of a prior art reference, Annby, to produce a composition of matter that is 'free of urea side products.' Since Annby is the closest art located in the prior art search, and yet this reference does not describe or suggest a composition of matter comprising a dendrimer which is free of urea side products, the claims now pending in this Application are in condition for allowance.


Appl. No. 09/963,858  
Amdt. dated March 1, 2006  
Reply to Office Action of September 6, 2005

PATENT

**CONCLUSION**

The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000.

Respectfully submitted,



Todd Esker  
Reg. No. 46,690

MORGAN, LEWIS & BOCKIUS, LLP  
One Market, Spear Street Tower  
San Francisco, California 94105  
Tel: 415-442-1000  
Fax: 415-442-1001  
TE:te

1-SF/7344707.1

-6